REMARKS

Claims 1-17 were pending in the Application. In the Office Action, claims 1-17 were rejected. Applicants have amended claim 1. Applicants have added new claims 18-23. As such, claims 1-23 are pending in the Application. Applicants respectfully request reconsideration and favorable action in this case in view of the following.

SPECIFICATION

Applicants have amended paragraph [051] on page 14. No new matter has been added.

SECTION 103 REJECTION

A.   Claims 1-5, 8, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,590,573 issued to Geshwind (hereinafter *Geshwind*) in view of U.S. Patent No. 6,111,597 issued to Tabata (hereinafter *Tabata*). Applicants respectfully traverse the rejection of claims 1-5, 8 and 16.

All Claim Limitations Not Taught Or Suggested By *Geshwind* And *Tabata*

It is well-settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, M.P.E.P. §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art.

Independent claim 1 recites "generating three-dimensional data defining a non-stereo image". According to the Office Action *Geshwind* discloses this element of independent claim 1, *see* col. 3, line 19, col. 8, lines 32-36 and col. 9, lines 36-38 of *Geshwind*. Applicants respectfully submit that this element of claim 1 is not taught or suggested by *Geshwind*. Applicants submit that the cited portion of *Geshwind* relates to 2-D images and there is no teaching or suggestion in the cited portion of *Geshwind* for "generating three-dimensional data defining a non-stereo image" as required by independent claim 1.

Independent claim 1 recites

assigning a first screen portion to a first rendering node;
assigning a second screen portion to a second rendering node;
rendering, by the first rendering node, a left image portion from the three-dimensional data;
rendering, by the second rendering node, a right image portion from the three-dimensional data;

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The Office Action cites col. 8, lines 10-20 of *Geshwind* as teaching the "assigning" elements of claim 1. The cited portion of *Geshwind* simply refers to "odd and even fields of a video frame" and it appears from the office action that the Examiner is incorrectly interpreting "rendering nodes" as being "screens" or "displays". The Examiner admits that *Geshwind* does not teach "rendering, by the first rendering node, a left image portion" and "rendering, by the second rendering node, a right image portion" as required by independent claim 1. However, the Office Action cites to col. 10, lines 35-40 of *Tabata* as teaching these two elements. Applicants submit that the cited portion of *Tabata* simply teaches displaying "images . . . represented by the left and right image data" on the "display screens of a left and a right liquid crystal display elements" and does not teach or suggest the above cited "rendering" elements of independent claim 1.

Furthermore, following the Examiner's mistaken assumption to its logical conclusion, it would appear that three displays or screens (a first one for rendering a left image portion, a second one for rendering a right image portion and a third one for rendering the composite image) would be required to be shown in the applied art to begin to approach some of the clearly stated limitations of independent claim 1. Moreover, the applied art would need to teach that each of these displays or screens specifically performed the clearly stated limitations of independent claim 1. As becomes quickly apparent, the Office Action simply fails to make a *prima facie* case.

Therefore, Applicants submit that even if the teachings of *Geshwind* and *Tabata* were combined, all the claim limitations of independent claim 1 would still not be taught or suggested as required to make a *prima facie* case of obviousness.

Lack Of Motivation For Combining The Teachings of *Geshwind* and *Tabata*

In rejecting claim 1, the Examiner states that "[i]t would have been obvious . . . to incorporate the rendering to obtain stereo display data as taught by Tabata into the compositing images of Geshwind's method for forming a stereo image, because it would supply as data representing images to be displayed on the screen, respectively, of the stereo image display (col. 4, lines 24-27)." Applicants respectfully traverse and request the Examiner to clarify the motivation for combining the teachings of the two references.

Applicants respectfully remind the Examiner, that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). Applicants submit that such desirability is lacking in the applied art.

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B.   Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,982,375, issued to Nelson et al. (hereinafter *Nelson*) in view of *Geshwind*. Applicants respectfully traverse the rejection of claim 6.

All Claim Limitations Not Taught Or Suggested By *Nelson* And *Geshwind*

It is well-settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, M.P.E.P. §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art.

According to the Office Action, *Nelson* discloses "a memory module maintaining a stereo transform application executable by the processing element (col. 4, lines 14-15)." Column 4, lines 14-15 of *Nelson* as reproduced in its entirety states "bus or system bus 104. A system memory 106 is also preferably coupled to the high speed bus 104." Applicants submit that there is no indication in the cited and applied portion that *Nelson* teaches or suggests a "memory module maintaining a stereo transform application" as required by independent claim 6.

Furthermore, independent claim 6 requires the stereo transform application maintained by the memory module to receive three-dimensional data defining a non-stereo image. As discussed above, *Nelson* does not teach or suggest a memory module maintaining a stereo transform application. Therefore, in *Nelson* three-dimensional data defining a non-stereo image, if any, is not received by a stereo transform application which is maintained by the memory module.

Therefore, even if the teachings of *Nelson* and *Geshwind* were combined, all the claim limitations of independent claim 6 would still not be taught or suggested as required to make a *prima facie* case of obviousness.

Lack Of Motivation For Combining The Teachings of *Nelson* and *Geshwind*

In rejecting claim 6, the Examiner states that "it would have been obvious . . . to incorporate the compositing image as taught by Geshwind into the stereo transform application of Nelson, because using such image pairs (left and right images) may be displayed by true 3D display systems to achieve synthetic stereoscopic image (col. 4, lines 27-30)."

The motivation provided in the Office Action is improper. The portion (col. 4, lines 27-30) of *Geshwind* cited by the Examiner talks about "true 3D display systems". The

Examiner has not provided any explanation as to the meaning of a "true 3D display system" or why the system of *Nelson* is a "true 3D display system" or why the invention of claim 6 is a "true 3D display system". Further, the required specific motivation to combine teachings of one reference with the teachings of another reference is not provided.

Applicants respectfully remind the Examiner, that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). Applicants submit that such desirability is lacking in the applied art.

C.   Claims 7 and 9-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Nelson* in view of *Geshwind* and further in view of U.S. Patent No. 6,147,695 issued to Bowen et al. (hereinafter *Bowen*). Applicants respectfully traverse the rejection of claims 7 and 9-15.

<u>All Claim Limitations Not Taught Or Suggested By *Nelson, Geshwind* and *Bowen*</u>

It is well-settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, M.P.E.P. §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art.

Claim 13 recites "a compositor node operable to receive a respective first data stream and a second data stream . . ., the compositor node operable to assemble the first data stream and the second data stream into a composite three-dimensional stereo image."

The Examiner appears to be relying on graphics pipeline 930 of *Bowen* to teach the "compositor node" of independent claim 13. The Office Action cites column 17, lines 51-67 of *Bowen* to purportedly teach the compositor node of claim 13. However, Applicants submit that nothing in the cited portion of *Bowen* teaches or suggests a compositor node as recited in independent claim 13. Further, Applicants submit that the "input commands" mentioned in *Bowen* do not teach or suggest "the first data stream" and "the second data stream." Furthermore, the graphics pipeline of *Bowen* is not operable to "assemble the first data stream and the second data stream" as recited in independent claim 13.

With respect to the other limitations of independent claim 13, the Office Action simply states "the rationale provided in the rejection of claims 1, 2 and 6 is incorporated herein." Applicants submit that claim 1 is rejected over *Geshwind* in view of *Tabata*, and claim 6 is rejected over *Nelson* in view of *Geshwind*. Because of the Examiner's statement,

Applicants are unsure as to precisely what combination of references the Examiner is relying on to reject claim 13. It is not clear whether claim 13 is rejected under *Nelson, Geshwind* and *Bowen*; *Geshwind, Tabata* and *Bowen*; or *Nelson, Geshwind, Bowen* and *Tabata*. Applicants respectfully request the Examiner to clarify the rejection of claim 13 so that Applicants may properly respond to the Examiner's concerns.

Nevertheless, Applicants submit that even if the teachings of the applied references were combined, all the claim limitations of independent claim 13 would still not be taught or suggested as required to make a *prima facie* case of obviousness.

<u>Lack Of Motivation For Combining The Teachings</u>

In rejecting claim 13 the Examiner states that "[i]t would have been obvious . . . to incorporate the network-based system as taught by Bowen into the displaying the stereo mode of Nelson's method, because it would improve performance for rendering object to be viewed in the stereo mode (col. 1, lines 10-11)." Applicants submit that claim 13 is not a method claim.

Applicants respectfully remind the Examiner, that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, *In re Mills*, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). Applicants submit that such desirability is lacking in the applied art.

D. DEPENDENT CLAIMS

Dependent claims 2-5, 7-12 and 14-17 are each directly or indirectly dependent from one of the independent claims. Accordingly, it is respectfully submitted that the dependent claims are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features.

E. NEW CLAIMS

Applicants have added new claims 18-23. Claim 18 depends from independent claim 1. For at least the reasons discussed above, claim 1 is in condition for allowance. Therefore, Applicants respectfully request allowance of new claim 18. Independent claim 19 recites "generating three-dimensional data defining a non-stereo image." This element of independent claim 19 is not taught or suggested by *Geshwind*. Therefore, Applicants respectfully request allowance of new claims 19-23.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of the application and allowance of all pending claims.

Please charge any deficiency payment or credit any overpayment associated with this communication to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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